



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,306	08/24/2001	Thomas Lemmons	2050.115US1	2562

44367 7590 06/21/2010
SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV
P.O. BOX 2938
MINNEAPOLIS, MN 55402-0938

EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
----------	--------------

3714

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

06/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
request@slwip.com

Office Action Summary	Application No. 09/939,306	Applicant(s) LEMMONS ET AL.	
	Examiner William H. McCulloch	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 17-44 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-44 and 51-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/7/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/7/2010 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) with mailroom date 6/7/2010 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the Examiner has considered the information disclosure statement.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17, 19-32 and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over W.O. 99/00163 to Eilat et al. (hereinafter Eilat).

Eilat et al. discloses an interactive game system played over a network between at least two players over a television broadcast. In addition to the players viewing the broadcast, non-player viewers can view the broadcast as well.

Regarding Claims 17, 27, 30, 39, and 40: Eilat et al. additionally discloses:

- a. launching an interactive game on a video game server (communication network) connected to said television broadcast system that controls play of said interactive game (Abstract, page 5, line 9-page 6, line 11, and page 7, line 7-page 8, line 18),
- b. embedding a first gaming code in a video broadcast stream, said first gaming code generated by said video game server and broadcast to a first set top box (14) at a specific address (player's set top box) in said video broadcast system, said first gaming code comprising a user interface for a first player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- c. embedding second gaming code in a video broadcast stream, said second gaming code generated by said video game server and broadcast to a second set top box (14) at another specific address (player's set top box) in said video broadcast system, said second gaming code comprising a user interface for a second player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- d. receiving at said video game server a game control signal that is generated in response to an input from said first player playing said interactive game, and

Art Unit: 3714

message data from said first set top box (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

e. generating video images in said video game server in response to said signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

f. inserting said video images into said video broadcast stream (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

g. transferring said message data from said video game server to said second set top box (Page 23, lines 7-13); and

h. broadcasting said video broadcast stream to a plurality of set top boxes including set top boxes of said at least two players and said at least one non-participating viewer with a video broadcast apparatus configured to transmit different ones of the video images for the players and for the non-participant viewers (Page 22, line 24-page 23, line 3).

Regarding claims 20 and 29: Eilat discloses combining said video images (first player character-avatar) with second video images (second player character-avatar) and broadcasting combined images to said plurality of set top boxes including said at least one set top box associated with a non-participating viewer (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding claim 21: Eilat discloses transmitting said game control signal to said second player (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding claim 22: Eilat discloses altering the display produced by said second set top box in response to said game control signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding claim 23: Eilat discloses generating video images that are an overview (outer view) of said interactive video game (Page 24, lines 8-26). A non-player may see the game from an "outer view", that is, to include a view of an outside viewer that watches the player as well as the environment in which the player acts.

Regarding Claims 26, 38, and 43: Eilat discloses that said interactive game is a game show game (Page 20, lines 4-9).

Regarding Claim 31: Eilat discloses that said network comprises a back-channel (network connection for communicating player control inputs) in said broadcast system (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding Claim 32: Eilat discloses that said network comprises a connection to the Internet (Page 14, lines 14-24).

Regarding Claim 34: Eilat discloses code that produces a first graphical image of said game in said first set top box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar may be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each combine their face with the player's avatar such that each viewer/player would have a unique view on the display.

Regarding Claim 35: Eilat discloses code that produces a second graphical image that differs from said first graphical image of said game in said second set top

Art Unit: 3714

box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar may be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each combine their face with the player's avatar such that each viewer/player would have a unique view on the display.

Eilat et al. lacks explicitly disclosing:

Regarding Claims 17, 27, and 39: embedding first markup language code in a video broadcast stream; and embedding second markup language code in said video broadcast stream.

Regarding Claims 19 and 28: embedding HTML code in said video broadcast stream.

Regarding Claims 24, 36, and 41: said interactive game is a sports game.

Regarding Claims 25, 37, and 42: said interactive game is a casino game.

Regarding claims 17, 19, 27, 28, and 39: Eilat discloses embedding first and second gaming code in a video broadcast stream. Furthermore, Eilat et al. discloses the video broadcast stream can be communicated over the Internet using Internet protocols. Embedding HTML (hypertext markup language) in a broadcast stream over a network, such as the Internet, was notoriously well known at the time of Applicant's invention. Embedding HTML signals in the broadcast enables the players gaming machine, set top box, and television to incorporate text, graphics, sound, and video associated with the game.

Art Unit: 3714

Regarding Claims 24, 25, 36, 37, 41, and 42, Eilat et al. discloses the interactive game is a game between a first and second player competing against each other (Page 8, lines 8-18). It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to implement well-known sports or casino games in Eilat. One would be motivated to do so because interactive sports and casino games are entertaining to game players.

5. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of U.S. 6,335,744 to Korilis et al. (hereinafter Korilis).

Eilat teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32 and 34-43. Regarding claim 44, Eilat seems to lack explicitly disclosing "wherein the registration of at least one of the first and second players is solicited through an advertisement." Korilis, like Eilat, teaches conducting games over a communication network. Therefore, Korilis and Eilat are analogous art. Korilis teaches a game designed to lure computer users (players) to different websites to play a game. Korilis teaches "wherein the registration of at least one of the first and second players is solicited through a television advertisement" (Column 1, lines 18-32, column 2, lines 32-45, and column 3, line 61-column 4, line 16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Korilis' registration feature in Eilat. The motivation to do so is because a player would be entertained playing the game and would be more likely to purchase a company's product by viewing the advertisement on the associated web site.

Art Unit: 3714

6. Claims 18 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of *Creating a live Broadcast from a Virtual Environment*, Computer Graphics Proceedings, Annual Conference Series, by Greenhalgh et al. (hereinafter Greenhalgh).

Eilat teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32, and 34-43. Regarding Claims 18 and 33, Eilat seems to lack explicitly disclosing “displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code.” Greenhalgh teaches an interactive game presented to conventional passive viewers (television broadcast audience) and to online participants (game players). Therefore, Greenhalgh and Eilat are analogous art. Furthermore, Greenhalgh teaches “displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code” (Figure 9 and page 380). It would have been obvious at the time of Applicant's invention to incorporate Greenhalgh's flying vehicle controls and video output in Eilat. One would be motivated to do so because this would enable a player lacking Eilat's “virtual reality kit” to generate player inputs to the game via a conventional personal computer mouse.

7. Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of U.S. 6,758,754 to Lavanchy et al. (hereinafter Lavanchy).

Eilat teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32, and 34-43. Eilat seems to lack explicitly disclosing the

Art Unit: 3714

assigning of the first or second player to a team. Lavanchy teaches a system and method for interactive game-play over a network, and thus Eilat and Lavanchy are analogous art. Lavanchy states that if more than one match (set of teams) has the same disparity of players from one team with players from another team, the system may place a player in a match with the fewest human players. Lavanchy further states that players may be randomly assigned to matches. See column 9, lines 47-65.

Lavanchy states that an object of the invention is to provide systems and methods for creating a compelling multi-player experience as well as to foster a community of like-minded sports fans (column 1, lines 65-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify Eilat to incorporate team assignment at least in order to allow players to create a community of like-minded players.

8. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of Korilis, in further view of Lavanchy.

Eilat teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32, and 34-43. As established above, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Korilis' registration feature in Eilat. Eilat in view of Korilis seems to lack explicitly disclosing the assigning of the first or second player to a team. It is clear that Eilat, Korilis, and Lavanchy are analogous art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Eilat in view of Korilis to incorporate

Art Unit: 3714

team assignment at least in order to allow players to create a community of like-minded players.

Response to Arguments

9. Applicant's arguments filed 6/7/2010 have been fully considered but they are not persuasive.

On page 13 of the Remarks section, Applicant states that claims 17, 27 and 44 have been amended to place them in server-side format and that each claim has been amended by adding the limitation that different ones of the video images can be transmitted to the players and to the non-participant viewers.

It is not clear how an amendment toward "server-side" formatting would materially change the invention. It appears that the claims are merely amended such that all operations and features of the invention are the same as those claims rejected previously, the only difference being that they are rearranged to show the perspective of the server. This does not result in any patentable difference over the prior art. Indeed, the Board of Patent Appeals and Interferences has already ruled that the previously-claimed invention was unpatentable (see Board decision 4/9/2010), and there appears to be no significant difference between those claims and the current claims. If there is any difference, it would be that portions of the previously-rejected claims have been cancelled, thus resulting in claims that are actually *broader* than those deemed unpatentable by the Board.

In terms of the video images being transmitted to the players versus those transmitted to the non-participant viewers, Eilat clearly teaches this feature on at least Page 22, line 24-page 23, line 3:

In a preferred embodiment of the present invention the first version of the interactive game may include a version of the game that is transmitted to all viewers that do not participate as interactive players in the game. Preferably, the second version of the interactive game may include a version of the game which is transmitted only to the player or players who is or are selected to interactively play the game as mentioned above. It is appreciated that the first version of the game may be different from the second version of the game. A preferred embodiment of first and second versions of the interactive game, and the differences between them are described below with reference to Figs. 6A and 6B.

Figures 6A and 6B show that the different versions of the game may be one version that is from an inside perspective transmitted to a player and from an outside perspective transmitted to a (non-playing) viewer.

In conclusion, this feature of the claims is taught by Eilat and was cited in prior Office Actions and the Examiner's Answer. The same grounds of rejection affirmed by the Board are applicable to the claims in their current state.

Conclusion

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3714

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
6/14/2010

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714